

REMARKS/ARGUMENTS

Reconsideration is respectfully requested. Claims 1-72 were pending in this application. In this amendment, claims 1-72 have been cancelled. Cancellation of the claims should in no way be construed as acquiescence to any of the rejections and was done solely to more particularly point out and distinctly claim the subject matter of the Applicants' invention. Furthermore, amendment and/or cancellation of the claims are not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

New claims 73-87 are also submitted with this amendment. New claims 73-87 are fully supported throughout the specification as filed. No new matter has been added. Accordingly, after entry of the present amendment, claims 73-87 will be under consideration.

RESTRICTION REQUIREMENT

A provisional election was made with traverse to the invention of Group IV, claims 4-6, 14-21, and 23-24 on 12/3/03. Applicants confirm election of Group IV with traverse on the basis that the Examiner's reasoning is unsupported by MPEP § 803.

According to MPEP § 803, restriction may be made if it imposes a serious search burden on the Examiner. A search for art describing a composition including an antibody will inevitably also encompass art describing methods for using the antibody and various applications of antibody compositions. Thus, Applicants contend that the inventions of Groups IV, V, and XVIII do not impose a serious search burden and should be examined together.

However, since claims 1-72 have been cancelled, Applicants submit that the restriction requirement is avoided.

Withdrawal of the restriction requirement is respectfully requested.

OBJECTIONS TO THE SPECIFICATION

The specification has been objected to for containing hyperlinks directed to Internet addresses. Pursuant to MPEP § 608.01, a hyperlink or a browser-executable code are a URL placed between the symbols “<>” and http:// followed by a URL address. Pages 9, 80, and 170 of the specification have been amended to remove the cited hyperlinks, thereby complying with MPEP 608.01 and overcoming the objection.

DEFECTIVE DECLARATION

The declaration has been cited as being defective because alterations made to the address of inventor Arthur B. Raitano are not initialed and dated.

Pursuant to 37 C.F.R. § 1.76, a change in an inventor's mailing address from that on the declaration may be changed by submission of an application data sheet. Thus, attached hereto is an application data sheet with the correct mailing address of Arthur B. Raitano.

CLAIM OBJECTIONS

Claim 4 is objected to for being drawn to non-elected inventions. Claim 4 has been cancelled. Thus, the objection is rendered moot.

Withdrawal of the claim objection is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 4-6, 14-21, and 23-24 stand rejected under 35 U.S.C. §112, second paragraph. With respect to claim 4, the Examiner states that the recitation of “modulates the status of 85P1B3” and “a molecule that is modulated by 85P1B3” is indefinite. With respect to claim 6, the Examiner states that the phrase “human unit dose form” is indefinite. With respect to claim 14, the Examiner states that the recitation of “antibody or fragment thereof that specifically binds to an 85P1B3-related protein” is indefinite. Claims 5, 14-21, and 23-24 depend from claim 4.

Applicants disagree. In addition, the rejections are rendered moot by the cancellation of claims 4-6, 14-21, and 23-24. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph are respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 4-6, 14-21 and 23-24 stand rejected under 35 U.S.C. §112, first paragraph. Specifically, the Office Action states that the specification does not reasonably provide enablement for 85P1B3-related proteins, 85P1B3-related protein variants, antibodies that bind 85P1B3-related protein variants, or pharmaceutical compositions comprising a substance that modulates the status of 85P1B3.

Again, Applicants disagree and submit that the rejections are rendered moot by the cancellation of claims 4-6, 14-21, and 23-24. Withdrawal of the rejections under 35 U.S.C. § 112, first paragraph is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e)

Claims 4-6, 14-21, and 23-24 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Tang Y.T., et al. (WO 01/53312).

Applicants disagree. As described above, the rejection is also rendered moot since claims 4-6, 14-21, and 23-24 have been cancelled. Applicants respectfully request withdrawal of the rejection.

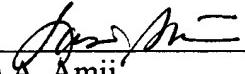
CONCLUSION

Applicants have by way of amendments and remarks presented herein, made a sincere effort to overcome rejections and address all issues that were raised in this Office Action. Accordingly, reconsideration and allowance of the pending claims is respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 511582002800.

Dated: May 21, 2004

Respectfully submitted,

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